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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/509,483

09/27/2004

Dae-Yoon Chi

428.1045

5413

20311

7590

09/25/2006

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EXAMINER

BERNHARDT, EMILY B

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 09/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/509,483	CHI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Emily Bernhardt	1624	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/27/04</u> . | 6) <input type="checkbox"/> Other: ____.  |

The abstract of the disclosure is objected to because it does not convey the structural makeup of applicants' invention. Correction is required. See MPEP § 608.01(b).

Claims 1-2 and 5-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. In the generic claims applicants employ the “~” symbol when defining alkyl ranges. Its not clear if this is suggesting a greater range than what is actually recited which would render the claims indefinite as to intended scope . It is suggested the symbol be replaced by " - " which is definite.
2. Claim 5 is an independent claim and thus needs to be complete as written. Thus the scope of recited “formula 1” must be set forth in the claim or the claim made into a dependent claim.
3. Claim 6 recites a “composition of claim 1” but claim 1 is directed to compounds. Even if “5” really intended said claim would not be further limiting the scope of claim 5 since intended uses in such claims are given no material weight. Note In re Tuominen 213 USPQ 89 and MPEP 2111.02.

Some typos are noted in claim 3. See 3<sup>rd</sup> species, piperazine spelling and the last species, nitro spelling.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee. The commonly assigned publication describes several compounds within the claims' scope for use in solution to determine IC50 values. See in Table 1 compounds 3,5, 7-9.

Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Duphar (NL'723, cited by applicants). The Dutch publication describes compounds within the instant scope and also made by the same process as herein. See examples I, II, IV,VII, VIII-X . While the compounds are isolated as salts the free base is first obtained as can be seen in example IV-note the text "vrije base" . The compounds are taught for use as pharmaceuticals as can be seen in example XII.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Bernhardt whose telephone number is 571-272-0664.

If attempts to reach the examiner by telephone are unsuccessful, the acting supervisor for AU 1624, James O. Wilson can be reached at 571-272-0661. The

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fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.



Emily Bernhardt  
Primary Examiner  
Art Unit 1624